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Application No. 10/797,583

REMARKS

Claims 1-22 are pending. Claims 13-22 stand withdrawn from consideration. By this Amendment, claim 12 is cancelled, claim 1 is amended and new claim 23 is added.

Election/Restrictions

Applicant thanks the Examiner for the opportunity to make a provisional election by telephone. The Examiner required restrictions to one of the following inventions under 35 U.S.C. § 121: group 1, claims 1-12; group 2, claims 13-14; group 3, claims 15-22. Applicant affirms the provisional election made in the telephone conversation of May 5, 2006 to elect claims 1-12 without traverse.

35 U.S.C. § 103

The Office Action rejected claims 1, 2, 6, and 8-12 under 35 U.S.C. § 103(a) as being unpatentable over Martin (U.S. Patent No. 5,480,380) in view of Ladika (U.S. Patent No. 4,747,840). By this amendment, applicant has amended claim 1 to include limitations previously recited in claim 12. With regard to the former claim 12, now incorporated into claim 1, applicant respectfully traverses the rejection.

With regard to claims 11 and 12, the Office Action cites MPEP § 2113 and cites to *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The Office Action indicates "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." As an initial matter, the holding of the cited case, *In re Thorpe*, is applicable only to product-by-process claims. None of the claims in the present application, including Claims 11 and 12, are written in the form of product-by-process claims. A product-by-process claim, as described by *In re Thorpe*, takes the form "The product

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of the process . . .” and recites the steps of a process or refers to a claim that recites process steps. The method, or process claims in this application, namely, claims 13-22, are unelected and stand withdrawn from consideration.

The Office Action goes on to state that claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin 380 in view of Ladika 840 since the end result product meets the recited structure, the manner of making is not limiting. Applicant respectfully traverses the rejection. Applicant respectfully points out that neither claim 11 or 12, and in particularly claim 12, refers to the manner of making the subject catheter. Claims 11 and 12 describe the structure of the subject catheter. Amended claim 1 recites “the inner lumen wall comprises braided extrusion reinforcement.” This limitation is supported in the written description, for example, at Page 5, Lines 16-17.

Even if this limitation had been presented in product-by-process format, the “product” is not disclosed or suggested by the Martin or Ladika reference individually or in combination, and the claim is traversed because all of the elements recited are not found in the prior art cited. The Martin reference is directed to a straight coaxial dual lumen catheter that includes “a relatively light thin walled (sic) inner tube material 30 to be used within a more robust outer tube material 28.” Column 4, lines 9-11. The Ladika reference is directed to a pigtail pulmonary arteriography catheter. Ladika teaches the use of a “pliable thin walled” tubing for its construction. Abstract; Column 2, Line 27; Column 2, Lines 41-43; Column 3, Lines 20-21. As amended, claim 1 now recites that the inner lumen wall includes “braided extrusion reinforcement to accommodate high pressure injections through the catheter.” This structure allows the catheter of the present invention to be used for high pressure contrast injections as well as for differential pressure measurement across the heart valve. This limitation is neither taught nor suggested by Martin or Ladika, individually, or in combination. In particular, Martin teaches an opposite approach: “a light thin walled inner lumen and a robust outer lumen wall.”

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Thus, both Ladika and Martin teach away from the applicant's invention, and a prima facie case of obvious cannot be made because all of the limitations recited in claim 1 are not present in the cited prior art. Therefore, claim 1, as amended, should be patentable over the Martin and Ladika references. Applicant respectfully requests that the Examiner withdraw the rejection. Claims 2-11 and new claim 23 depend directly or indirectly from claim 1 and should be patentable for at least the same reasons as discussed above for claim 1.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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